REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed July 31, 2003. In the Office Action, the Examiner notes that claims 1-28 are pending of which claims 1-24 are rejected and claims 25-28 are subject to restriction and/or election requirement. By this amendment, the Applicants have amended claims 1-2, 5-6, 8-13, 16-17, and 21-24, cancelled claims 14-15 and 19-20, claims 25-28 are withdrawn, and claims 3-4, 7, and 18 continue unamended.

In view of both the amendments presented above and the following discussion, the Applicants submit that none of the claims now pending in the application are directed to non-statutory subject matter, anticipated, or obvious under the respective provisions of 35 U.S.C. §101, §102, and §103. Thus, the Applicants believe that all of these claims are now in allowable form.

It is to be understood that the Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

ELECTION/RESTRICTIONS

The Examiner notes that restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-24, drawn to a method or collecting information related to an information distribution system;

II. Claims 25-28, drawn to a method for providing information in an information distribution system, classified in class 715, subclass 10.

In a telephone conversation with the Examiner on July 23, 2003, Applicants' attorney Eamon J. Wall elected the claims of Group I, namely, claims 1-24 with traverse. Applicants' attorney hereby confirms such oral election with traverse.

THE REJECTIONS

a. 35 U.S.C. §101

The Examiner has rejected claims 1, 14 and 15 under 35 U.S.C. §101 "because the claimed invention is directed to non-statutory subject matter." Applicants respectfully traverse the rejection.

The Applicants have amended claim 1 to further clarify the features that the Applicants consider as being inventive.

Independent claim 1, as amended, recites:

> "In an interactive information distribution system comprising provider equipment and subscriber equipment comprising a plurality of set-top terminals (STTs), a method for providing video-on-demand (VOD) programming based on subscriber preferences, comprising:
> receiving, at said provider equipment via a back channel formed between each STT and said provider equipment, subscriber selections associated with an interactive program guide, said interactive program guide sent to said subscriber equipment via a forward distribution channel formed between said provider equipment and said subscriber equipment;
> determining, at said service provider equipment, trend data associated with at least one subscriber, said trend data representing repeated subscriber selections occurring as said subscriber equipment; and
> providing said VOD programming to said at least one subscriber based on said trend data." (emphasis added).

Applicants' amended claim 1 recites features for a process that provides "a useful, concrete and tangible result." State Street Bank & trust v. Signature Financial Group, 149 F.3d 1368, 47 USPQ2d 1596 at 1601 (Fed. Cir. 1998) cert. denied, 119 S. Ct 851 (1999). In particular, the Applicants' claim 1 provides VOD programming to at least one subscriber based on trend data. The trend data is determined at the service provider equipment upon receiving subscriber selections via a back channel from a set-top terminal. Such subscriber selections are made by a subscriber interfacing with a set-top terminal. Thus, the Applicants' invention is not merely directed to a human making mental computations and manually receiving, determining, re-evaluating and

presenting. Therefore, claim 1, as amended, recites features for a process that provides "a useful, concrete and tangible result."

The Applicants further submit that claim 1, as originally filed is also not directed to non-statutory subject matter under 35 U.S.C. §101. Specifically, originally filed claim 1 provided a process that included receiving user inputs at a terminal. A terminal is a computer device that interacts with a user. Further, the step of "collecting trend data based on the received user inputs" is also performed by a non-human entity, since the claim recites the limitation "received" user inputs. The received user inputs are at the terminal, which is not a human being. Moreover, the "reporting the collected trend data" is sent to a "server" in the information distribution system. Thus, a tangible result is the sending of the trend data to the server, which is not performed by a human being. Therefore, claim 1, as originally filed recites features for a process that provides "a useful, concrete and tangible result." However, in view of the amendment of independent claim 1, such rejection of claim 1 is now considered moot.

As such, the Applicants submit that claim 1, as amended, is not directed to non-statutory subject matter and fully satisfies the provision under 35 U.S.C. §101 and is patentable thereunder. Furthermore, claims 14-15 and 19-20 have been cancelled, and claims 16-18 and 21-24 have been amended to depend, either directly or indirectly to independent claim 1 and these dependent claims recited additional features thereof. As such, and for at least for the same reasons discussed above, the Applicants submit these dependent claims are also not directed to non-statutory subject matter and fully satisfy the provision under 35 U.S.C. §101 and are patentable thereunder. Therefore, the Applicants respectfully request that the rejections be withdrawn.

b. 35 U.S.C. §102

The Examiner has rejected claims 1-9 and 11-24 under 35 U.S.C. 102(e) as being anticipated over Hendricks et al. (U.S. Patent No. 6,539,54[illegible], hereinafter "Hendricks"). Applicants respectfully traverse the rejection.

The Applicants have cancelled independent claims 14, 15, 19, and 20 and have amended claims 16-18 and 21-24 to depend, either directly or indirectly to independent

claim 1. Further, the Applicants have amended claim 1 to further clarify the features that the Applicants consider as being inventive.

Independent claim 1, as amended, recites:

> "In an interactive information distribution system comprising provider equipment and subscriber equipment comprising a plurality of set-top terminals (STTs), a method for providing video-on-demand (VOD) programming based on subscriber preferences, comprising:
>
> receiving, at said provider equipment via a back channel formed between each STT and said provider equipment, subscriber selections associated with an interactive program guide, said interactive program guide sent to said subscriber equipment via a forward distribution channel formed between said provider equipment and said subscriber equipment;
>
> determining, at said service provider equipment, trend data associated with at least one subscriber, said trend data representing repeated subscriber selections occurring as said subscriber equipment; and
>
> providing said VOD programming to said at least one subscriber based on said trend data." (emphasis added).

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindenmann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears Roebuck & Company, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). The Hendricks reference fails to disclose each and every element of the claimed invention, as arranged in the claim.

In particular, the Hendricks reference discloses an Operations Center that allows for the organizing and packaging of television programs for transmission in a television delivery system (see Hendricks, col. 3, lines 12-16). A Computer Assisting Packaging (CAP) System retrieves viewer data, and assimilates the data into program packaging, via retrieval of raw data from the set-top terminals, and then filtering and presenting that data. Each headend compiles the viewer data, and then sends it verbatim to the Operations center. Menu creation, both automatically and manually, is one of the major CAP functions that involves the incorporation of the raw data. An automated software

procedure analyzes the data and, using certain heuristics, creates the menus (see Hendricks, col. 16, lines 13-40).

Nowhere in the Hendricks reference is there any teaching or suggestion of "a method for providing video-on-demand (VOD) programming based on subscriber preferences," and "providing said VOD programming to said at least one subscriber based on said trend data." That is, the Hendricks reference is limited to providing television programming, as opposed to video-on-demand programming. Therefore, the Hendricks reference fails to teach each and every element of the claimed invention, as arranged in the claim.

As such, the Applicants submit that independent claim 1, as amended, is not anticipated and fully satisfies the requirements under 35 U.S.C. § 102 and is patentable thereunder. Furthermore, claims 2-13, 16-18, and 21-24 depend, either directly or indirectly, from independent claim 1 and recite additional features hereof. As such, and at least for the same reasons as discussed above, the Applicants submit that these dependent claims also fully satisfy the requirements of 35 U.S.C. §102 and are patentable thereunder. Therefore, the Applicants respectfully request that the rejections be withdrawn.

c. 35 U.S.C. §103

The Examiner has rejected claim 10 as being obvious under 35 U.S.C. §103 over Hendricks et al. (U.S. Patent No. 6,539,548, hereinafter "Hendricks"). The Applicants respectfully traverse the rejection.

Claim 10 depends from independent claim 1 and recites additional features thereof. In particular, claim 10 recites in part:

> "In an interactive information distribution system comprising provider equipment and subscriber equipment comprising a plurality of set-top terminals (STTs), a method for providing video-on-demand (VOD) programming based on subscriber preferences, comprising:
> receiving, at said provider equipment via a back channel formed between each STT and said provider equipment, subscriber selections associated with an interactive program guide, said interactive program

guide sent to said subscriber equipment via a forward distribution channel formed between said provider equipment and said subscriber equipment;

determining, at said service provider equipment, trend data associated with at least one subscriber, said trend data representing repeated subscriber selections occurring as said subscriber equipment; and

providing said VOD programming to said at least one subscriber based on said trend data." (emphasis added)."

The test under 35 U.S.C. § 103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Thus, it is impermissible to focus either on the "gist" or "core" of the invention, Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 USPQ 416, 420 (Fed. Cir. 1986) (emphasis added). Hendricks fails to teach the Applicants' invention as a whole.

As discussed above, the Hendricks reference merely discloses an Operations Center that allows for the organizing and packaging of television programs for transmission in a television delivery system (see Hendricks, col. 3, lines 12-16). Nowhere in the Hendricks reference is there any teaching or suggestion of "a method for providing video-on-demand (VOD) programming based on subscriber preferences," and "providing said VOD programming to said at least one subscriber based on said trend data." That is, the Hendricks reference is limited to providing television programming, as opposed to video-on-demand programming. Therefore, the Hendricks reference fails to teach or suggest the Applicants' invention as a whole.

As such, the Applicants submit that claim 10 is not obvious and fully satisfies the requirements under 35 U.S.C. §103 and is patentable thereunder. Therefore, the Applicants respectfully request that the rejection be withdrawn.

CONCLUSION

The Applicants believe all the claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring the issuance of an adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Steven M. Hertzberg or Eamon J. Wall, Esqs. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

10/28/03

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